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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,226	10/19/2001	Max Azevedo	01P124	7397

21884 7590 12/22/2003

WELSH & FLAXMAN LLC
2450 CRYSTAL DRIVE
SUITE 112
ARLINGTON, VA 22202

EXAMINER	
ROBERTS, PAUL A	

ART UNIT	PAPER NUMBER
3731	5

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/982,226	AZEVEDO, MAX	
	Examiner	Art Unit	
	Paul A Roberts	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) *10-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9 drawn to a method of making an adhesive, drawn to 606, classified in class 214.

II. Claims 10-12, drawn to a container for an adhesive, classified in class 604, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case there alternative materially different structures that can contain the adhesive of group I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Howard Flaxman on Dec 9th 2003 a provisional election was made without traverse to prosecute the invention of group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

1. Claim 6 is objected to because of the following informalities: "and frangible ampoule" should be changed "a frangible ampoule". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 6 claim that the cyanoacrylate has the stabilizer removed coincidentally with the application of the cyanoacrylate. Coincidentally means 'at the same time' or it can mean subsequently. While the removing of the stabilizer and the application of the cyanoacrylate do happen within a few seconds of each other, they do not happen at exactly the same time. The examiner has noted the repeated disclosure in the specification that these two steps happen coincidentally, but it remains unclear what the applicant means by coincidentally.

3. Assuming that the applicant's means these steps happen simultaneously, there would be insufficient disclosure to enable this feature of the invention because there is no disclosure of how these steps can happen at the same time. As disclosed, it appears these steps can only occur succession.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 6 are rejected under 35 U.S.C. 112 because it is unclear what the applicant is trying to claim. The reason for the lack of clarity is the claims can be interpreted as either a

method of making an adhesive or a method of using an adhesive. Adding language such as "A method of fabrication comprising...' or 'A method of using an adhesive' would obviate this rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyatlov '292. The wording of the Jepson claim states that it is known in the art to provide an adhesive composition comprising cyanoacrylate adhesive and a stabilizing agent, present a substrate to receive at least a portion of said cyanoacrylate adhesive, and apply said cyanoacrylate adhesive portion to said substrate. Thus the answer to the question of would it have been obvious to remove stabilizing agent coincidentally to the step of application will ultimately affect the claims unobviousness over the prior. Dyatov discloses the practice of removing acid from cyanoacrylates because acid slows the curing process. This is done by exposing the acrylate to metallic agents selected from the group of metal, metal oxide, metal hydrides, or mixtures thereof. Since the acid slows the reaction, it acts as a stabilizer. Therefore its removal makes the cyanoacrylate bond more rapidly. From Dyatov, we have the method of removing stabilizers from a cyanoacrylate to improving the curing rate of the compound. Still, there is one additional matter to this rejection that needs to be clarified, which is; does the disclosure of Dyatov disclose

the step of coincidentally removing the stabilizer as the cyanoacrylate is applied? The answer depends on what the applicant means by coincidentally. If coincidentally is taken mean the adhesive is destabilized and then the adhesive is applied to a substrate, Dyantov renders obvious this limitation, because adhesives are designed to be applied to a substrate. At the time of the invention it would have been obvious to one having ordinary skill in the art to apply the Dyantov adhesive to a substrate because adhesives are designed to be applied to substrates.

Double Patenting

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6667031. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite essentially the same subject matter. The difference between the use of 'prior' vs. 'coincidentally' is not seen as a patentably distinct difference because coincidentally is taken to mean prior as interpreted by reading the specification.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art discloses various stabilizers used in conjunction with cyanoacrylates. Some stabilizers are disclosed to increase or decrease the curing time of the acrylate. US references 6294629 5749956 4182823 5475110

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Paul Roberts
Paul.Roberts@uspto.gov
12/12/03

MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700